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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,262	02/12/2002	Wei C. Moline	57451US002	5027

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/074,262

Applicant(s)

MOLINE, WEI C.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 32, 34 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-31, 33, 35 and 37-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 7. 6) ☐ Other: .

### **DETAILED ACTION**

Claims 1-45 are pending. Claims 12-14, 32, 34 and 36 are withdrawn from consideration, as they are directed to non-elected subject matter.

#### ***Information Disclosure Statement***

The information disclosure statement filed 6/14/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The US Patents on the IDS of 6/14/03, Paper No. 5, have been considered, as they are readily available to the Examiner. However, none of the Foreign Patent Documents or Non-Patent Literature have been considered, as these documents have not been provided.

#### ***Election/Restrictions***

Applicant's election of poly(ethoxylated and/or propoxylated) alcohol in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The Examiner has additionally searched poly(ethoxylated and/or propoxylated) esters.

The search was not extended beyond these species because prior art was found to anticipate and render obvious the species.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The term “derivative” in claims 1 (D and E), 15 (lines 5, 6, and 7—the term in lines 3-4 is definite, as it is defined in the spec), 20 (D and E) is vague and indefinite, as the metes and bounds of these claims are unascertainable. What does derivative mean? Does it mean the addition of a hydroxyl group? The deletion of a hydroxyl group? The addition of an amide group? The deletion of an oxygen atom? What are the metes and bounds of the term “derivative”? The specification does not further define this term and one of ordinary skill in the art would not be apprised of its meaning. Deleting the term “derivative” will overcome this rejection.

(ii) The term "major" in claim 25 (line 3) is a relative term which renders the claim indefinite. The term "major" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 3-7, 10, 15, 18-20, 23-24, 33, 38, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Asmus (6,090,395).

Asmus et al. exemplify a composition comprising alkyl alcohol/long chain polyethoxylate thickener system comprising 1.5% beheneth ether (polyethoxylated ester

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emulsifier), 0.25% unithox 470, 1.1% behenyl alcohol, 0.05% cetyl palmitate (wax emollient), 1% diisopropyl dimerate (liquid emollient), 1% squalane (liquid emollient), 0.5% dimethicone L45/350, 95% PEG glycol 900 (polymeric thickening agent), 0.3% PEG 600 (carbowax 600/polymeric thickening agent), 0.45 glycerol (emollient), 22% water, 66% ethyl alcohol (lower alcohol), and 5% chlorhexidine gluconate solution, wherein the composition was applied by numerous volunteers and found to have very nice cosmetic properties. While the exemplification does not explicitly teach that application is to the skin, the compositions of Asmus et al. are only taught for application to the skin. The ratio of ethanol to water is 3:1. The thickener system, Part A of the exemplified composition, comprises 5.4% of the composition as a whole. The compositions are taught as having a melt temperature of greater than about 25 C, when in the absence of an auxiliary thickener, a viscosity of at least about 4,000 cps at 23 C, when in the absence of an auxiliary thickener, wherein the viscosity is measured using a very low shear viscometer and T spindles with a heliopath adapter, and as not separating by more than about 10% by volume when centrifuged for 30 minutes at 2275xg, see Col. 41, lines 35-44.

The recitation "of reducing skin irritation associated with shaving" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The claims are directed to a method of applying a composition comprising a lower alcohol and water in a weight ratio of 20:30-100:0, and 0.5%-8% of a thickener system, wherein the system comprises at least 0.05% of a specific emulsifier to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce skin irritation associated with shaving as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, reciting the composition as an aftershave or a pearlescent is a future intended use of the composition and is not given patentable weight.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8-9, 11, 16, 17, 21, 22, 25-31, 35, 37, 39-44 are rejected under 35

U.S.C. 103(a) as being unpatentable over Asmus et al. as applied to claims 1, 3-7, 10, 15, 18-20, 23-25, 31, 33, 38, and 45 above.

The instant invention is directed toward a method of reducing skin irritation associated with shaving comprising applying to the skin a lower alcohol and water in a ratio of 20:30-100:0, and 0.5-8% of a thickener system, wherein the system comprising 0.05% of a specific emulsifier, as recited in the instant independent claims.

Asmus et al. is applied as discussed above. For a hydrophilic lipophilic balance of 2-20, see Col. 7, lines 11-19. For polyethoxylated and/or polyethoxylated alcohols and esters and derivatives thereof, see Col. 9, line 37-Col. 10, line 5. The alky group is taught as preferably at least 22 carbon atoms long. For salts, emollients, stabilizers, fragrances and additional emulsifiers as additional ingredients, see Col. 12, lines 26-34. For preferred embodiments comprising emollient systems of wax and oil emollients, see Col. 14, lines 30-53. For a ratio of wax to liquid emollients of 5:1-1:5 and preferably between 1:3-3:1, see Col. 13, lines 44-47. For dialkoxo dimethicone and polyether/polysiloxane copolymers as emollients see Col. 15, line 50-Col. 16, line 7. For aerosol foams or mousses, see Col. 17, line 33. For UV absorbers (sunscreens), see Col. 17, lines 56-57. For viscosities of 4,000cps-500,000 cps at 23 C, see Col.

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6, lines 14-28. The reference lacks an exemplification of a viscosity of at least about 45,000 centipoise after 19 days at 23 C.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the compositions of Asmus et al. as having a viscosity of at least 45,000cps after 19 days at 23 C because of the expectation of achieving a composition with low flow and hence, greater control for the user when applying the composition to the skin, and because Asmus et al. teach that their compositions with higher viscosities are more preferable. Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

It is respectfully pointed out that fragrances and perfumes are synonyms.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

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